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OFFICE OF PETITIONS

In re Application of	:	
Boyd et al.	:	
Application No. 09/517,983	:	ON PETITION
Filed: 3 March, 2000	:	
Attorney Docket No. 82001-0313	:	

This is a decision on the petition, styled under 37 CFR 1.47(a) and filed on 8 December, 2003, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.63 where they require that a supplemental declaration be executed by the named inventor.¹

The Office apologizes for the delay in responding to the present petition.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

This application was filed on 3 March, 2000. On 5 June, 2000, a declaration was filed naming Dean Boyd, Mike Gordon, Jorgen Andersson, Chia-Hung Tai, Feng Yang, Anapuma Kolamala, Greg Cook, Thomas Guardino, Mudita Purang, Prabhakar Krishnamurthy, Mark

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

Cooke, Ravi Nandiwada, Brian Montiero, and Steve Haas as joint inventors.

On 6 June, 2003, a non-final Office action was mailed, requiring, *inter alia*, a new oath or declaration signed by all of the inventors because the original oath or declaration contained non-initialed and/or non-dated alterations.² A three (3)-month shortened statutory period for reply was specified.

In response, on 8 December, 2003, the present petition was filed, accompanied by a three (3) month extension of time, an amendment, and an oath or declaration submitted in compliance with 37 CFR 1.63 and 1.67 naming Boyd et al. as joint inventors and signed by all joint inventors except Boyd, Andersson, Yang, Kolamala, Cook, and Guardino. Petitioners further state that a copy of the declaration and application was sent to joint inventors Yang and Andersson, but that the declaration was returned as undeliverable.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by both joint inventors, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

Petitioners' showing is deficient in that proof of diligent efforts to locate the non-signing inventor have not been made.³ Specifically, if the letter containing the declaration was refused or returned as undeliverable, petitioners should provide a copy of the envelope showing that the letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts having first-hand knowledge of the details.

²37 CFR 1.52(c).

³MPEP 409.03(d).

Additionally, no showing has been made with regard to non-signing inventors Boyd, Kolamala, and Cook. If petitioners wish to have the supplemental declaration accepted without their signatures, petitioners must provide a showing as stated above with regard to those inventors as well.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at 571-272-3231.



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